

**REMARKS**

**I. INTRODUCTION**

Claims 89-93, 95, 98, 101-104, 106, 107, 136-141, 144, 147-150 and 152-154 have been amended to clarify the subject matter recited therein so as to include the recitation of the term “hardware” for each of the recited processing arrangements. Claims 89-107 and 136-152 are under consideration in the above-referenced application. Provided above, please find a claim listing indicating the amendments to claims 89-93, 95, 98, 101-104, 106, 107, 136-141, 144, 147-150 and 152-154 on separate sheets so as to comply with the requirements set forth in 37 C.F.R. § 1.121. It is respectfully submitted that no new matter has been added.

**II. REJECTION UNDER 35 U.S.C. § 101 SHOULD BE WITHDRAWN**

Previously-pending claims 89-107 and 136-154 stand finally rejected under 35 U.S.C. § 101 as being allegedly directed to non-statutory subject matter. Applicants respectfully disagree that these claims allegedly fail to comply with the requirements of 35 U.S.C. § 101 as being directed to non-statutory subject matter for at least the reasons as presented herein below.

Applicants respectfully submit that these claims are fully compliant with 35 U.S.C. § 101, as interpreted by the Federal Circuit case law, and as indicated below. Due to the arguments presented herein below, and in view of the amendments to independent claims 89, 136 and 154, the rejection under 35 U.S.C. § 101 of claims 89-107 and 136-154 should be withdrawn.

35 U.S.C. § 101 clearly provides that “[w]hoever invents or discovers any new and useful process machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the condition and requirements of this title.” Indeed, it has been held that inventions that encompass algorithms and/or software are patentable subject matter under 35 U.S.C. § 101. The correct standard to apply for rejecting the claims of an application under 35 U.S.C. § 101 has been set forth in by the court in the *State Street* case. See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373 (Fed. Cir. 1998) (referring to *In re Freeman*, 574 F.2d 1237 (CCPA 1978), *In re Walter*, 618 F.2d 758 (CCPA 1980), *In re Abele*, 684 F.2d 902 (CCPA 1982)).

It has been held that “[u]npatentable mathematical algorithms are identified by showing they are merely abstract ideas constituting disembodied concepts or truths that are not ‘useful.’” *State Street Bank & Trust Co. v. Signature Financial Group, Inc.*, 149 F.3d 1368, 1373. The State Street court asserted that “the Freeman-Walter-Abele test has little, if any, applicability to determining the presence of statutory subject matter.” *Id.* at 1374. In particular, the court held that in order to comply with the requirements of 35 U.S.C. §101, the claimed invention must produce “a useful, concrete and tangible result.” *Id.* at 1373. This standard has been referred to in the Manual of Patent Examining Procedure 2106(IV). The claimed inventions may contain, e.g., computer programs, logic/software arrangements, etc., which produces “as a whole, a tangible, useful … result.” *AT&T Corp. v. Excel Communications, Inc.*, 172 F.3d 1352, 1361 (Fed. Cir. 1999).

First, in the Final Office Action dated January 28, 2008, the Examiner alleges that “the processing arrangement and system are software modules, … [that s]oftware, per

se, is not within a statutory category of invention.”, and points to page 7, lines 13-22 in support of such position. (Final Office Action, p. 2, Ins. 7-9). As an initial matter, independent claim 89 recites a computer accessible medium which includes computer-executable instructions thereon, such computer accessible medium is certainly not software, *per se*. With respect to independent claims 136 and 154, these claims recite system and computer system, respectively, each of which comprises processing arrangements. Clearly, while such processing arrangements execute software to perform certain procedures, these processing arrangement can in no way be considered software, *per se*, much less software modules as alleged by the Examiner. Further, the exact section of the specification pointed to by the Examiner provides an indication which is contrary to that of the Examiner – instead, it describes physical hardware processing arrangements (e.g., processing devices 3 which can include, e.g., a microprocessor chip). (See Applicants’ specification, e.g., p. 7, Ins. 19-22). Other portions of the specification provide a clear disclosure of such subject matter. (See *id.*, e.g., p. 6, Ins. 9-31). Thus, the processing arrangements recited in independent claims 89, 136 and 154 cannot be stated as being merely software, *per se*.

Then, in the latest Final Office Action, the Examiner states that the “procedures recited in the claim [sic] are not actually executed, the language implies that the procedures are capable of being executed.” (Final Office Action, p. 2, Ins. 9-11). Certainly, to comply with the requirements of 35 U.S.C. § 101, it is surely not necessary for the processing arrangement(s) recited in independent claims 89, 136 and 154, which are specifically configured or programmed to perform certain procedures, to actually perform such procedures. Indeed, the recited processing arrangements are not merely “capable” of

performing the explicitly recited procedures – they are specifically “configured” or “programmed” to do so in full compliance with 35 U.S.C. § 101.

Further, the Examiner follows with an alleged confirmation “that the processing arrangements, procedures and system are software.” (Final Office Action, p. 2, Ins. 11-12). As indicated above, the arrangements recited in independent claim 89, 136 and 154 are not merely software, *per se*. Further, there is absolutely no statutory or case law support for any clearly inappropriate proposition that a claim directed to a software arrangement is nonstatutory. However, there is clear case law that provides guidance regarding software system or software arrangements that is contrary to the Examiner’s position. In particular, the court in the *Eolas Technologies* case stated that “[w]ithout question, software code alone qualifies as an invention eligible under ... [35 U.S.C. § 101].” *Eolas Technologies Inc. et al. v. Microsoft Corp.*, 399 F.3d 1325, 1338 (Fed. Cir. 2005). Thus, it is clear that the recited arrangement(s) of claims 89, 136 and 154 are surely within the realm of 35 U.S.C. § 101.

In addition, independent claims 89, 136 and 154 recite computer-readable medium, system and computer system, respectively, and certainly comply with the suggestions as set forth in as set forth in M.P.E.P. 2106.01, 2<sup>nd</sup> paragraph. Indeed, as clearly provided in M.P.E.P. 2106.01(l), 3<sup>rd</sup> paragraph, “USPTO personnel should determine whether the computer program is being claimed as part of an otherwise statutory manufacture or machine. In such a case, the claim remains statutory irrespective of the fact that a computer program is included in the claim.” Thus, even if the Examiner believes that independent claim 89, 136 and 154 recite computer programs, such purported computer programs are claimed as a part of statutory manufacture or machine, i.e.,

computer accessible medium, system and computer system, as recited in independent claims 89, 136 and 154, respective, and such comply with the requirements of 35 U.S.C. § 101.

Finally, while Applicants disagree with the Examiner's contentions that claims 89-107 and 136-154 are not directed to statutory subject matter, independent claims 89, 136 and 154, and certain claims which depend therefrom, have been amended herein to provide that the arrangement(s) recited therein is/are "hardware" arrangement(s). Thus, for such additional reason, independent claims 89, 136 and 154, and the claims which depend therefrom are surely within the realm of 35 U.S.C. § 101.

Accordingly, Applicants respectfully assert that amended independent claims 89, 136 and 154, as well as the claims which depend therefrom, recite statutory subject matter pursuant to 35 U.S.C. § 101 for this further reason. Thus, for the reasons discussed above, Applicants respectfully request that the rejection of claims 89-107 and 136-154 under 35 U.S.C. § 101 be withdrawn.

### **III. REJECTION UNDER 35 U.S.C. §§ 102(e) AND 103(a) SHOULD BE WITHDRAWN**

Claims 89-96, 102-104, 106, 136-142, 148-150, 152 and 154 stand finally rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,029,165 issued to Gable (the "Gable Patent"). Claims 97-101, 105, 143-147 and 151 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the Gable Patent, in view of U.S. Patent No. 5,978,842 issued to Noble et al. (the "Noble Patent"). Claims 107 and 153 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over the Gable Patent, in view of U.S. Patent No. 6,029,175 issued to Chow et al. (the "Chow Patent").

The present application was filed on January 26, 1997. The Gable Patent, issued on February 22, 2000 and filed with the U.S. Patent and Trademark Office on November 12, 1997, is relied on by the Examiner as a reference under 35 U.S.C. § 102(e) for rejecting claims 89-96, 102-104, 106, 136-142, 148-150, 152 and 154 of the present application under 35 U.S.C. § 102(e) as being allegedly anticipated by this publication. In addition, the Gable Patent was relied on by the Examiner as a primary reference to reject claims 97-101, 105, 143-147 and 151 under 35 U.S.C. § 103(a) as being allegedly obvious over this reference, in alleged combination with the Noble Patent. Further, the Gable Patent was relied on by the Examiner as a primary reference to reject claims 107 and 153 under 35 U.S.C. § 103(a) as being allegedly obvious over this reference, in alleged combination with the Chow Patent.

Pursuant to 37 C.F.R. § 1.131, the Gable Patent can be antedated by filing a declaration establishing that the date of the present invention was earlier than the earliest effective 35 U.S.C. § 102(e) date of the '981 Publication, and that Applicants worked diligently to reduce the present application to practice thereafter (i.e., up to the filing of the present application). See 37 C.F.R. § 1.131. The earliest effective filing date of the Gable Patent is the filing date of the U.S. Patent Application Serial No. 08/967,775 from which the Gable Patent issued, i.e., November 12, 1997.

Accordingly, Applicants submit herewith a declaration pursuant to 37 C.F.R. § 1.131 executed by the inventors of the present application in which it is confirmed that the invention recited at least in currently-pending independent claims 89, 136 and 154 of the above-referenced has been invented by Applicants prior to November 12, 1997, i.e., the earliest effective § 102(e) filing date of the Gable Patent, and that Applicants worked

diligently to reduce the present application to practice thereafter (i.e., up to the filing of the present application). Accordingly, the Gable Patent is not applicable for rejecting independent claims 89, 136 and 154 and claims which depend therefrom under 35 U.S.C. § 102(e) and also under 35 U.S.C. § 103(a). Further, without combining with the Gable Patent, the Noble Patent and the Chow Patent fail to teach or suggest the subject matter recited in independent claims 89, 136 and 154 and the claims which depend therefrom, and the Examiner does not contend that they do.

Therefore, Applicants respectfully assert that the Gable Patent has been antedated and cannot be used for a rejection of independent claims 89, 136 and 154, as well as the claims which depend therefrom, under 35 U.S.C. §§ 102(e) and 103(a). For at least this reason, Applicants respectfully request that the rejection of claims 89-96, 102-104, 106, 136-142, 148-150, 152 and 154 under 35 U.S.C. § 102(a) as allegedly being anticipated by the Gable Patent, of claims 97-101, 105, 143-147 and 151 as being allegedly unpatentable over the Gable Patent in combination with the Noble Patent, and of claims 107 and 153 as being allegedly unpatentable over the Gable Patent in combination with the Chow Patent, be withdrawn.

IV. CONCLUSION

In light of the foregoing, Applicants respectfully submit that all pending claims 89-107 and 136-152 are in condition for allowance. Prompt consideration, reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

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